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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/637,397	08/11/2000	Cary Lee Bates	ROC920000093US1	7305

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EXAMINER

BOCCIO, VINCENT F

ART UNIT	PAPER NUMBER
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2616

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/637,397

Applicant(s)

BATES ET AL.

Examiner

Vincent F. Boccio

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— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2</u> . | 6) <input type="checkbox"/> Other: ____. |

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DETAILED ACTION

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 2616.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. Claims 1-2, 4-8, 10-16, 18-21, are rejected under 35 U.S.C. 102(e) as being anticipated by Kitsukawa (US 6,282,713).

Regarding claims 1 and 8, Kitsukawa in Fig. 3 meets the limitations of a recording system recording presentable data accessed thru interactive links displayed by an interactive TV program, the system comprising:

- an interactive TV recording device (col. 6, "selection of a broadcast for automatic recording");
- an interactive TV transceiver (Fig. 3, "2") for receiving an interactive TV signal (col. 5, "header that identifies ... advertising data"),
- including at least one interactive Link associated with presentable data (col. 3, "data links to advertising information");
- a writing device for writing the interactive TV signal to a first storage and writing presentable to a second and in response to a record input (col. 6, recording function);
- the system accesses the presentable data (col. 7, "in store Ad mode"), associated with the link and records the Video, links and Ad data

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to storage, since the first and second are claimed to be different or the same, the mere storage of all information as claimed is met.

Regarding claim 2, Kitsukawa further meets the limitation of separately recording the interactive TV signal and the link information (col. 4, video to disk, col. 6, links SRAM 36, advertising SRAM 51), but, it is noted that the storage medium, now a second in addition to a first medium, are not claimed to be separated from each other, but, read on multiple storage locations, which each location is separate from each other or wherein each data has its own area is a medium.

Regarding claims 4, 10 and 18, upon a play operation from the user the interactive Tv signals are retrieved from storage, wherein in response to link the presentable data is displayed, even to another link, wherein more presentable data, would be downloaded, stored and rendered, reference claim 6 etc. below.

Regarding claims 6, 7, 12, 20-21, Kitsukawa further meets the limitations of wherein upon playback the AD info, can include another interactive link (col. 8, lines 50-60, "Ad info. may include ... electronic links over the internet to the Web pages of product manufactures and dealers"), therefore, upon selecting, storing the additional Web pages, therefore separately storing the presentable data to storage in addition to previously stored data, from a WEB site.

Regarding claim 13, Kitsukawa further meets the limitation of a set top box, provides for a network communication device for accessing a WEB site from a network (col. 8, "links to additional Web pages from displayed Ad info."), further provides disk storage which is coupled to the set top box in order to receive, record and reproduce data to and from storage or the mediums.

Regarding claim 14, Kitsukawa further meets the limitation of wherein the interactive TV system is a set-top box, as shown in (Fig. 2, "2"), having a signal processor (Fig. 3), wherein the processor processes the signals for display and recording and reproduction and provides for a communication to a network (WEB page access) relates to links and since but fails to particularly show wherein the SET top Box is coupled {} to the interactive TV

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recording device, interpreted as coupled thereto, or outside the STB.

Claims 5, 10-11, are analyzed and discussed with respect to the claims above.

Claims 15-16 and 18-19 are analyzed and discussed with respect to the claims above, but, the claims recite an additional limitation, such as a program product comprising:

O a control program for performing the steps as recited (met by Fig. 3, "CPU", with program, col.5, line 56 to col. 6-, CPU with control program facilitate the steps of operation the program in memory, code stored in memory 37).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

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4. Claims 3, 9, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitsukawa et al. (US 6,282,713).

Regarding claims 3 and 9, Kitsukawa discloses recording the interactive the links and presentable data in a recording mode,

but fails to disclose recording to tape, recording the interactive TV program and at least one link on a first track and recording the presentable data elsewhere on the tape.

The examiner takes official notice that recording various information various areas, such as the video tracks, control tracks or areas, is well known, therefore, it would have been obvious to one skilled in the art at the time of the invention modify Kitsukawa by recording to a tape type medium the Interactive TV signal and the links, starting from a first track and to also pre-store or simultaneously record, the presentable data (WEB content), on the tape type medium in a location other the location of the interactive TV signal and Links, being an obvious design choice to store and utilize a tape type recording medium and various well known obvious areas to record to and create the data structure as claimed, as is considered to be obvious to one skilled in the art.

Claim 17 is analyzed and discussed with respect to the claims above.

Contact Fax Information

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communication
intended for entry)

or:

(703) 308-5359, (for informal or draft
communications, please label "PROPOSED" or
"DRAFT")

Hand-delivered responses should be brought to
Crystal Park II, 2121 Crystal Drive, Arlington,
VA., Sixth Floor (Receptionist).


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Contact Information

1. Any inquiry concerning this communication or earlier communications should be directed to the examiner of record, Monday-Thursday, 8:00 AM to 5:00 PM Vincent F. Boccio (703) 306-3022.

Any inquiry of a general nature or relating to the status of this application should be directed to Customer Service (703) 306-0377.

Primary Examiner, Boccio, Vincent
8/18/04


VINCENT BOCCIO
PRIMARY EXAMINER